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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,992	05/03/2001	Wilfried Lubisch	49500	7169

26474 7590 04/02/2002

KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/02/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on January 16, 2002
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-26 are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-26 are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/830,992

DETAILED ACTION

Claims 1-26 are pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 (page 11), under the definition of R^2 , there is a valence problem in the substituent $NR^{22}R^{23}OH$. In claim 1 (page 13), under the definition of R^{52} , "C1-C6 alkyl" should be changed to "C₁-C₆ alkyl". In claim 1 (page 14), under the definition of R^{53} , "Cl" should be changed to "Cl" (e.g. chlorine) and "CCl₃" should be changed to "CCl₃" (e.g. trichloromethyl). Also see claim 2 (page 18) for same.

In claim 1 (page 15), there are definitions for variables R^{31} and R^{32} . However, it is not clear what R^{31} and R^{32} are defining since the variables do not appear on the structure of Formula I or II nor are the variables used in other variable definitions in claim 1. It is noted that R^{31} is used in an expression defining R^3 in claims 2 and 3.

The definition of the K variable in claim 1 (page 15) is confusing. The expressions "at most two substituents on the being, comprising $NR^{k1}R^{k2}$ wherein R^{k1} and R^{k2} re" and "substituted by an alkyl radical C_1 - C_6 -alkyl" found in the definition of the K variable is unclear as to its meaning. It is not clear if K represents a substituent other than phenyl or if the substituents following "on the being" are possible substituents on the phenyl ring. Originally, the K variable represented a phenyl which may carry at most two substituents R. The R was not defined in the claim. Also under the definition of K in claim 1, "are" is misspelled.

What is "arid" under the definition of R^{21} and R^{22} in claim 2 (page 17)? The use of "can be" in claim 2 under the definition of R^{53} is indefinite because it implies additional unrecited substituents.

Claims 2 and 3 are replete with variables (e.g. R^{31}) and substituents which lack antecedent basis from claim 1. See in claim 2, for example, wherein R^2 is an alkyl, CN, $NR^{21}R^{22}$, $NHCOR^{23}$, OR^{21} ; the definition of R^3 ; R^4 being $NR^{41}R^{42}NH-CO-R^{43}OR^{41}$; R^5 being $NR^{51}R^{52}$; R^{52} being C_{1-6} alkylphenyl, $-(C=O)R^{53}$, etc. Also see the following.

Claim 6 lacks antecedent basis from claim 1 because of R^2 representing a C_{1-6} alkyl and CN. Claim 7 lacks antecedent basis from claim 1 because of the definitions of R^3 and R^{31} and its definitions, etc. Claim 8 lacks antecedent basis from claim 1 because of the definition of R^3 . Claim 9 lacks antecedent basis from claim 1 because of R^{52} being an optionally substituted phenyl ring. Review of antecedent basis and correction in claims 2-9 is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Application/Control Number: 09/830,992
Art Unit: 1626

Page 5

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in cursive script, reading "Laura L. Stockton". The signature is written in dark ink and is positioned above the printed name.

Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

April 1, 2002